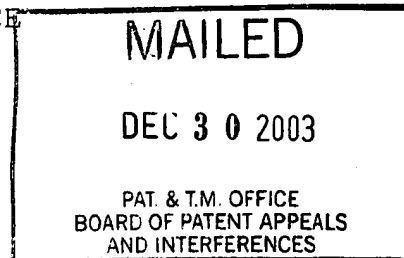


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte SUSAN HUBERMAN and STEVEN B. DUNN

Appeal No. 2002-0821
Application No. 09/417,399

ON BRIEF

Before ABRAMS, GARRIS, and FRANKFORT, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-14, 16-18 and 20-36, which are all of the remaining claims in the application.

The subject matter on appeal relates to a teething toy comprising a book-like structure wherein a non-toxic teething element is attached to a page or leaf of the book-

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like structure and wherein the teething element contains no sharp edges and is sized and dimensioned to be comfortably inserted into an infant's mouth for teething purposes. This appealed subject matter is adequately illustrated by independent claim 1, which reads as follows:

1. A teething toy, comprising:

a book-like structure having a plurality of leaves; and a teething element that is attached to at least one of said leaves, said teething element being fabricated from a non-toxic material and being sized and dimensioned to be comfortably inserted into an infant's mouth for teething purposes, said teething element further having no sharp edges capable of injuring an infant, whereby it will be safe for an infant or small child to place his or her mouth on said teething element.

The references relied upon by the examiner are:

Lomas	5,217,256	Jun. 8, 1993
Lee	5,626,366	May 6, 1997

All of the claims on appeal stand rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention.

The examiner considers three separate phrases used in various appealed claims to be indefinite under the second paragraph of Section 112. First, independent claims 1, 14, 18 and 26 recite the limitation "sized and dimensioned to be

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comfortably inserted into an infant's mouth" which the examiner considers indefinite because "the size of an infant's mouth can vary considerably" (final Office action, page 2). Second, dependent claims 3 and 30 recite the limitation "integrated into said artwork," which the examiner considers "vague and indefinite" (final Office Action, page 2) as well as "ambiguous in the context of the claims" (Answer, page 5). Finally, independent claim 14 recites the limitation "gripping means comprising teething means" and independent claim 18 recites the limitation "leaf weight means comprising teething means." The examiner considers this phrasing structure "indefinite and contradictory" (final Office action, page 2) because the "appellant is using different terms to define the exact same structure" which thereby makes it unclear "which term actually limits the claim" (Answer, page 6).

Claims 1-5, 7-8, 12-14, 16-18 and 20-25 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lomas.

Claims 9 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lomas.

Claims 1 and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lee.

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We refer to the Brief and to the Answer and final Office action (Paper No. 8) for a complete exposition of the opposing viewpoints expressed by the Appellants and by the Examiner concerning the above noted rejections.

OPINION

For the reasons set forth below, we cannot sustain the examiner's rejections of the appealed claims.

The §112, Second Paragraph Rejection

A. "Sized and dimensioned to be comfortably inserted into an infant's mouth"

As stated above, it is the examiner's position that the appealed claim phrase "sized and dimensioned to be comfortably inserted into an infant's mouth" is indefinite because the size of an infant's mouth "can vary considerably" (final Office action, page 2). The examiner notes that the size of an infant's mouth will vary both with the age of the child and also between different children of the same age. These variables, the examiner asserts, make it impossible to meet the requirements of the second paragraph of Section 112.

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The appellants respond that it is well known within the field of baby products what size articles fit comfortably within an infant's mouth. To support this statement, appellants refer to the guidelines for sizing teethingers, pacifiers and feeding nipples issued by the Consumer Product Safety Commission and the American Society for Testing and Materials (see page 5 of the specification). Appellants also cite Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986), a case in which the claim limitation "so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats" was scrutinized for compliance with the second paragraph of Section 112. Despite the fact that the space between the doorframe of an automobile and one of the seats is highly variable and dependent on the type of automobile, the court ruled that "so dimensioned" was as accurate as the subject matter permitted and was therefore definite. Appellants analogize the facts of this case with the Orthokinetics case and argue that the phrase "sized and dimensioned to be comfortably inserted into an infant's mouth" is as accurate as the subject matter permits and therefore definite.

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The examiner responds by stating that the Orthokinetics case is not on point, as the case does not address the concept of defining physical structure with respect to the human anatomy. The examiner also adds that there is a difference between the ability of an infant to teeth an item and the ability of an infant to comfortably fit an item in its mouth, yet the claims recite both.

We cannot agree with the examiner that the phrase "sized and dimensioned to be comfortably inserted into an infant's mouth" is indefinite under the second paragraph of, Section 112. The test for definiteness under 35 U.S.C. 112, second paragraph is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would

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understand what is claimed, in light of the specification.

Id.

In light of appellants' specification and including the reference therein to the guidelines for sizing teethers, pacifiers and feeding nipples issued by the Consumer Product Safety Commission and the American Society for Testing and Materials, it is our determination that one of ordinary skill in the art would understand what is meant by the claim phrase "sized and dimensioned to be comfortably inserted into an infant's mouth." While the claim language may not be as precise as the examiner would desire, this alone does not render the claim phrase indefinite when there is support in the specification to indicate to one of ordinary skill in the art what is being claimed. The concepts involved in the Orthokinetics case are the same as the case before us.

While the issue of comparing physical structure to human anatomy may not be addressed, the holding is still on point and supports our view that the claim phrase would be understood by an artisan and is as accurate as the subject matter permits. Appropriate dimensions of the teether would be discernible to one of ordinary skill in the art in light of the guidelines set forth in the specification, and the

claim phrase "sized and dimensioned to be comfortably inserted into an infant's mouth" therefore complies with Section 112, second paragraph.

B. "Integrated into said artwork"

Similar reasoning applies to the claim phrase "integrated into said artwork." In his Answer, the examiner states that it is unclear what definition should be given to the word "integrated" and the claim is therefore indefinite. While the examiner is correct that several definitions may be given to the word "integrated," an artisan would understand from appellants' specification which definition is intended. Figures 6 and 7 as well as the description of the drawings (Specification, bottom of page 6 through page 7) clearly indicate that the teething element is made to appear as part of the illustration located on the page the teething element is attached to. Two examples are given. The appellants describe the first example as being "made to appear as if [the teething element] is part of the pile of hay that a horse in the artwork is preparing to eat. In this embodiment, the teething element may further be colored bright yellow, so as to blend in with the pile of hay that is shown in the artwork" (specification, pages 6 and 7).

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The second example "includes a barn that is partially covered by a tree. In this example the teething element is made to appear to be part of the tree, and is preferably colored so as to be bright green, thereby representing the color of the leaves that are on the tree. The texture of the teething element may also be made consistent with the expected leaf like structure of the tree" (Specification, page 7). Appellants further explain in the Specification that the phrase "integrated into said artwork" means "the teething element appears to be an integral part of the artwork itself" (Specification, page 7). In light of the Specification, we interpret the claim phrase "integrated into said artwork" to mean that the teething element is positioned, colored, shaped and/or textured so as to make it appear to be an integral part of the artwork. As so interpreted, the claim phrase cannot be regarded as indefinite under the second paragraph of 35 U.S.C. § 112.

C. "Gripping means comprising teething means" and "leaf weight means comprising teething means"

Finally, we also conclude that the criticized language of independent claims 14 and 18 is not indefinite under the second paragraph of Section 112. While the examiner

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contends on page 6 of the Answer that "the scope of claims cannot be determined since it is not clear which terms will actually limit the claim scope," we find support in the specification to adequately inform the public of the boundaries of protection defined by these claims. At the bottom of page 4 continuing to the top of page 5 of the Specification, Appellants describe how the "presence of the teething elements makes it easier for small hands to grip and turn the leaves of the book-like structure. In addition, the weight of the teething elements tends to keep the pages of the book-like structure from flipping or closing, making it easier to keep from losing one[']s place." With this description in mind, we determine that the claim 14 phrase "gripping means comprising teething means" and the claim 18 phrase "leaf weight means comprising teething means" would convey to one of ordinary skill in the art that the teething element may also serve the purpose of making the page easier to grip or heavier so as to keep the book-like structure open to the page that the teething element is attached to. Applying the standard set forth in Orthokinetics and Seattle Box Co. leads us to conclude that the claims at issue satisfy the second paragraph of Section

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112 because one of ordinary skill in the art would understand in light of the specification what has been claimed.

The §102(b) Rejections

Claims have been rejected as being anticipated by Lomas and by Lee. At the outset, we wish to point out that whereas the appellants' claims are directed to a "teething toy" (claims 1-5, 7, 8 and 11-13) and to a book-like article comprising "teething means" (claims 18 and 20-25), which are intended to be inserted into an infant's mouth and chewed upon, Lomas discloses a paper stack protection device having a triangular-shaped pocket to be stapled over a corner of a group of stacked pages and Lee is drawn to a book cover corner guard to be installed over a corner of a page or book cover. It is clear that neither the Lomas nor the Lee articles are intended to be used in the manner of those recited in the appellants' claims, for the references do not express concern for the problems encountered if they are placed in an infant's mouth and chewed upon, and the articles do not appear to be of such construction as to reasonably accommodate such usage.

A. The Lomas Reference

With reference to the rejection under 35 U.S.C. §102(b) based on Lomas, the appellants argue that the reference fails to disclose either expressly or inherently every element of independent claims 1 and 14. The appellants contend that the §102(b) rejection is improper because the following six elements, which are contained in claims 1 and 14, are not disclosed by the reference: (1) a teething toy, (2) a book-like structure having a plurality of leaves, (3) a teething element, (4) a teething element fabricated from non-toxic material, (5) a teething element that is sized and dimensioned to be comfortably inserted into an infant's mouth and (6) a teething element having no sharp edges. With respect to independent claim 14, appellant further distinguishes Lomas from the claim by arguing that Lomas does not disclose a gripping means.

In his Answer, the examiner begins by addressing each of the limitations appellants argued to be missing from Lomas. The examiner first states that the "teething" limitation appears in the preamble of claims 1 and 14 and thus the Manual of Patent Examining Procedure (MPEP) §2111.02 (see Rev. 1, Feb. 2003) governs and no patentable weight is

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required to be attributed to that term. The examiner further contends on this point that the structure of the invention disclosed in Lomas is capable of being teathed and thus would satisfy the limitation if it were to be attributed patentable weight. The examiner next states that because the Lomas reference discloses a stack of papers bound together, the "book-like structure" limitation is satisfied. The examiner again asserts that element 10 of the Lomas reference is capable of being teathed and therefore satisfies the limitation of a "teething element," but also states that "teething" is only an intended use and should therefore not be accorded patentable weight. With regard to the non-toxic material of the teething element, the examiner contends that there is no suggestion in Lomas that the material used to form element 10 is toxic. In addressing whether Lomas discloses that element 10 is "sized and dimensioned to be comfortably inserted into an infant's mouth," the examiner states that this cannot be determined because the size of an infant's mouth is not defined. Nevertheless, the examiner contends that element 10 of Lomas could be bitten or teathed and therefore satisfies the claim limitation. Finally, the examiner maintains that element 10

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has no sharp edges because the staple used to attach element 10 to the paper stack is not part of element 10.

To begin the discussion on the §102(b) rejection, we note that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). We also note that in order for a §102 rejection to be proper, "the reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

While the examiner asserts that all the elements as set forth in claims 1 and 14 are found in Lomas, where he errs is in picking, choosing and combining from the references those parameters that would specifically make the object capable of being teethered in the manner and fashion required by the claimed invention where there is no guidance to do so. Element 10 of Lomas may be teethered as the examiner

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asserts, but all the limitations of the claimed invention are obtained only if one were to pick, choose and combine selected, specific parameters (e.g., size and dimension that allows the object to be comfortably inserted into an infant's mouth, having no sharp edges, made from a non-toxic material, etc.) with the specific goal in mind of making a suitable teething toy. The reference fails to describe a teething toy and therefore does not provide guidance on which parameters to select and combine in order to successfully achieve a teething toy. In fact, picking and choosing from the reference certain elements that lend themselves towards creation of a teething toy still may not lead to the creation of the specific teething toy claimed by appellants. In short, there are too many variables that need to be satisfied before the Lomas reference can be said to expressly or inherently disclose each and every element of the claimed invention.

Further, it is well established that an anticipation rejection cannot be predicated on an ambiguous reference. In re Turlay, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962). In order to meet every limitation of the claimed invention, the examiner would also have to show that the

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Lomas reference discloses a teething element made from a non-toxic material. The examiner asserted in his Answer that there was no suggestion in the reference that the material used was toxic and therefore concluded the element was made from non-toxic material. This is mere speculation on the part of the examiner and is neither an express nor inherent disclosure that the element is made from non-toxic material. This further lends support to our conclusion that the 102(b) rejection is improper.

We note that neither the Brief nor the Answer addresses independent claim 18, which includes the additional limitation of "leaf weight means . . . comprising teething means." Regardless, since independent claim 18 contains all the limitations of independent claims 1 and 14, our reasoning for overturning the §102(b) rejection as to claims 1 and 14 applies to our decision to overturn the §102(b) rejection of claim 18.

For the above stated reasons, the examiner's rejection of independent claims 1, 14 and 18 and correspondingly of dependent claims 2-5, 7-8, 12-13, 16-17 and 20-25 based on Lomas is improper and cannot be sustained.

B. The Lee Reference

As to the §102(b) rejection of independent claim 1 based on Lee, the appellants argue that the rejection is improper for the same reasons as indicated in the argument against Lomas (i.e., the same limitations are missing from Lee as well).

In addressing the appellants' arguments against the Lee reference, the examiner first asserts in his Answer that the "teething" limitation appears in the preamble of claims 1 and thus MPEP §2111.02 governs and no patentable weight should be attributed to that term. The examiner further contends on this point that the structure of the invention disclosed in Lee is capable of being teethered and thus would satisfy the limitation if it were to be attributed patentable weight. Next, the examiner states that no hard surfaces or sharp edges are illustrated by the Lee reference and therefore Lee satisfies the claim limitation that the teething elements have no sharp edges. The examiner also maintains that the Lee reference does not disclose the use of toxic ingredients and therefore concludes that the appellants' argument is baseless. Additionally, in addressing whether Lee discloses that element 10 is "sized

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and dimensioned to be comfortably inserted into an infant's mouth," the examiner states that this cannot be determined because the size of an infant's mouth is not defined.

Nevertheless, the examiner contends that element 10 of Lee could be bitten or teethed and therefore satisfies the claim limitation. Finally, the examiner reiterates that the Lee reference does not recite the presence of sharp edges and points out that none of the materials suggested for use in manufacture of element 10 (i.e., leather, cardboard and coated paper) could logically have sharp edges.

We again refer to In re Arkley, 455 F.2d at 587, 172 USPQ at 526, and In re Turley, 304 F.2d at 899, 134 USPQ at 360, as support for our conclusion that the §102(b) rejection based on Lee is improper. All the limitation of claim 1 are obtained from the reference only if one were to pick, choose and combine selected and specific parameters with the specific goal in mind of making a teething toy. There is no guidance in the reference for constructing the invention thereof in a manner that makes it suitable for a teething toy of any kind much less the particular teething toy claimed by appellants. Moreover, like the Lomas reference, Lee contains ambiguity problems with regard to

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the non-toxic material limitation of appealed claim 1. Therefore, we also cannot sustain the §102(b) rejection of independent claim 1 and dependent claim 11 as being anticipated by Lee.

The §103 Rejection

Dependent claims 9 and 10 are rejected under 35 U.S.C. §103 as being obvious over Lomas. Claims 9 and 10 recite specific minimum dimensions that the teething element cannot fall below, the dimensions being taken from guidelines for teethingers issued by the Consumer Product Safety Commission and the American Society for Testing and Materials. Appellants argue that the §103 rejection based on Lomas is improper because Lomas is not analogous art to the claimed invention and also because the reference fails to disclose the stated dimensions or any suggestion why one in the art would be motivated to size the invention of Lomas in such a way that would conform to the stated dimensions of claims 9 and 10.

In response, the examiner argues that the dimensions would have been obvious to one of ordinary skill in the art at the time of the invention.

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The deficiencies discussed above with respect to the \$102 rejection would remain even if the Lomas reference were modified as proposed by the examiner in his \$103 rejection.

SUMMARY

The decision of the Examiner is reversed.

REVERSED

Neal E. Abrams
Administrative Patent Judge

Bradley R. Garriss
Bradley R. Garriss
Administrative Patent Judge

Charles E. Frankfort
Charles E. Frankfort
Administrative Patent Judge

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